

PATENT APPLICATION

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER 1772**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

To Examiner
9/4/01
⊕
In re the Application of

Andrés RIVERA et al.

Group Art Unit: 1772

Application No.: 09/353,592

Examiner: S. Hon

Filed: July 15, 1999

Docket No.: 101054

For: APPLICATOR FOR A POLYMERIZABLE MONOMER

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Director of the U.S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

In reply to the Office Action mailed June 4, 2001, applicants respectfully request reconsideration of the application in view of the following remarks.

Claims 1-30 are pending herein. By the Office Action, claims 1-30 are rejected under 35 U.S.C. §103(a). Applicants respectfully request reconsideration of these rejections.

Claims 1-14 and 16-30 are rejected under 35 U.S.C. §103(a) as having been obvious over Leung. Claim 15 is also rejected under 35 U.S.C. §103(a) as having been obvious over Leung. Because the rejections are similar, they will be addressed together. Applicants respectfully traverse these rejections.

Independent claim 1 is directed to an applicator for dispensing a polymerizable or cross-linkable material, comprising: an outer container; an inner container disposed within said outer container, said inner container containing a polymerizable or cross-linkable

material; and a rate modifier for said polymerizable or cross-linkable material disposed on an outer surface of said inner container. Independent claim 24 is directed to a method of making an applicator for dispensing a polymerizable or cross-linkable material, comprising sealing a polymerizable or cross-linkable material in an inner container; applying a rate modifier for the polymerizable or cross-linkable material to an outer surface of said inner container; and disposing the inner container within an outer container having dispensing means for dispensing the polymerizable or cross-linkable material from the applicator. Leung would not have rendered obvious the claimed invention, because Leung fails to teach or suggest each and every limitation of the claimed invention. In particular, Leung fails to teach or suggest at least the limitation that a rate modifier for the polymerizable or cross-linkable material is disposed on an outer surface of said inner container.

Similar to the claimed invention, Leung is directed to an applicator for dispensing a synthetic or semi-synthetic polymerizable or cross-linkable monomer material. According to Leung, the applicator comprises an applicator tip comprising a solid support having a polymerization or cross-linking accelerator or initiator for the synthetic or semi-synthetic monomer material disposed thereon or therein, and a container body. The synthetic or semi-synthetic monomer material is located in the container body in a non-contacting relationship with the tip prior to dispensing the material. See Leung at Abstract and claim 1. For example, an embodiment of the disclosed applicator is shown in Leung Figure 3. According to Figure 3, the applicator of Leung includes an outer container 200 and an inner container 400 that contains an amount of monomer material 300 therein. According to this embodiment, the applicator tip 500 has the polymerization or cross-linking accelerator or initiator for the monomer material disposed therein or thereon. See also Leung at column 7, line 66 to column 8, line 4.

Leung also discloses several modification of the disclosed applicator. For example, Leung discloses that the polymerization or cross-linking accelerator or initiator can be located in the applicator at a position other than being loaded in or on the applicator tip. For example, at column 10, lines 43-53, Leung teaches that the accelerator or initiator may be stored in a separate compartment within the outer container 200 separate from the polymerizable or cross-linkable monomer material. Alternatively, in the same passage, Leung discloses that "the applicator container may be lined or coated with the initiator ... for example, in the device of FIG. 3, the initiator may be coated on the internal surface of body 200."

Although Leung discloses these modifications of the disclosed applicator, Leung does not teach or suggest all of the limitations of the claimed invention. In particular, Leung at most discloses that the accelerator or initiator may be lined or coated on the internal surface of the outer container 200. However, this disclosure is entirely different from the limitation of independent claims 1 and 24 that the rate modifier for the polymerizable or cross-linkable material is disposed on an outer surface of the inner container. For example, with reference to Figure 1 of the present application, the rate modifier 50 according to the claimed invention is lined or coated on the outer surface of the inner container 40.

In order to have rendered obvious the claimed invention, the cited reference must teach or suggest each and every limitation of the claimed invention. See, for example, MPEP §2143, which specifies the requirements for a prima facie case of obviousness. However, in the present case, Leung fails to teach or suggest modifying the disclosed applicators so as to arrive at the claimed invention. Leung fails to teach or suggest an applicator, or a method of making an applicator, where a rate modifier for the polymerizable or cross-linkable material is applied to an outer surface of the inner container. Nowhere does Leung teach or suggest

this limitation, nor does Leung teach or suggest that a method of making the applicator could or should be modified so as to arrive at the claimed invention.

In response to these arguments, the Office Action argues that the phrase "lined or coated" in Leung must be given two separate and distinct meanings. The Office Action argues that one of ordinary skill in the art would understand the phrase to mean that the accelerator or initiator may be coated on the outer surface of the inner container or lined on an inner surface of the inner [sic, outer] container. See Office Action at page 3, first paragraph. Applicants respectfully disagree.

As used in Leung, the phrase "lined or coated" was not used, and would not be understood to mean, two alternative embodiments. Rather, the phrase merely used two interchangeable words to mean the same embodiment. "Coat" is defined as ". . . 3. A layer of material covering something else; coating." American Heritage Dictionary, Second College Edition, p. 285 (1991). Likewise, "line" is defined as "line² . . . to fit a covering to the inside surface of . . . to cover the inner surface of." American Heritage Dictionary, Second College Edition, p. 733 (1991). (Copies of the dictionary definitions are enclosed for the Examiner's convenience.) Thus, both words refer to a layer or covering applied to another surface, i.e., the inner surface of the outer container. However, as used in Leung, the words are used in conjunction with reference to the outer container, specifying "the applicator container may be lined or coated with the initiator" (emphasis added). Nowhere does Leung use the phrase "lined or coated" with respect to the inner container, or even imply that one of "lined" or "coated" was used with respect to the inner container. Thus, one of ordinary skill in the art would readily understand that both words referred to placing the initiator in the inner surface of the outer container, and not to placing the initiator on the outer surface of the inner container, as claimed.

It is clear that the only motivation for modifying Leung to arrive at the claimed invention, or for interpreting the disclosure of Leung as asserted in the Office Action, derives only from the instant application. One of ordinary skill in the art would not have interpreted the recited phrase of Leung to have rendered obvious the claimed invention in the absence of the present disclosure. However, this is improper. The reason, suggestion or motivation for modifying a references "can not come from the applicant's invention itself." In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). That is, the motivation for modifying the embodiments of Leung can not be a product of hindsight reconstruction of the claimed invention based on applicant's own disclosure.

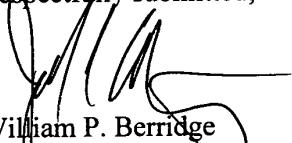
Leung does not teach or suggest the instant claim limitation of applying a rate modifier for the polymerizable or cross-linkable material to an outer surface of the inner container. Although Leung discloses various embodiments of an applicator for applying a monomer material, those embodiments are different from and would not have rendered obvious the claimed invention. In the disclosed applicator of Leung, the accelerator or initiator for the monomer material is described as being loaded in or on an applicator tip, or being coated on an inner surface of the outer container of the applicator. However, Leung fails to teach or suggest applying the rate modifier (initiator or accelerator) to an outer surface of the inner container.

Accordingly, Leung fails to teach or suggest each and every limitation of the claimed invention. The claimed invention would thus not have been obvious over the disclosure of Leung. Reconsideration and withdrawal of the rejections are respectfully requested.

In view of the foregoing remarks, Applicants respectfully submit that the application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

Should the Examiner believe that anything further is necessary in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned Attorney at the telephone number listed below.

Respectfully submitted,



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WPB:JSA

Attachment:

American Heritage Dictionary, Second College Edition, pp., 285, 733 (1991)

Date: August 28, 2001

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**The
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ABBREVIAT

FOUR-YEAR

TWO-YEAR

PICTURE CR

line *line* **n.** 1. A straight or curved line. 2. A line of type or printing. 3. A line of text. 4. A line of business. 5. A line of argument. 6. A line of conduct. 7. A line of communication. 8. A line of defense. 9. A line of fire. 10. A line of sight. 11. A line of travel. 12. A line of work. 13. A line of study. 14. A line of research. 15. A line of inquiry. 16. A line of investigation. 17. A line of exploration. 18. A line of discovery. 19. A line of invention. 20. A line of creation. 21. A line of production. 22. A line of manufacture. 23. A line of distribution. 24. A line of sale. 25. A line of purchase. 26. A line of exchange. 27. A line of trade. 28. A line of commerce. 29. A line of industry. 30. A line of profession. 31. A line of occupation. 32. A line of vocation. 33. A line of service. 34. A line of duty. 35. A line of responsibility. 36. A line of authority. 37. A line of command. 38. A line of control. 39. A line of supervision. 40. A line of management. 41. 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A line of multiplication. 415. A line of addition. 416. A line of subtraction. 417. A

A diagram showing a magnetic field with two poles, represented by two small black dots. Field lines are shown as curved lines emerging from the top pole and entering the bottom pole, with some lines extending horizontally to the left and right.

line of force
Electric lines of force
Above: Equal but
similar charges
($+q, +q$)
Below: Equal but
opposite charges
($+q, -q$)